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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,334	10/04/2000	Keith Henning	COREMET-003	6560
34399	7590	08/17/2004	EXAMINER	
GARLICK HARRISON & MARKISON LLP P.O. BOX 160727 AUSTIN, TX 78716-0727			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/679,334

Applicant(s)

HENNING ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 21-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3622

DETAILED ACTION

1. Claims 1-12 and 21-32 have been examined.

Response to Amendment

2. The Amendment filed on 6/28/04 is sufficient to overcome the Gardenswartz reference.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1-12, 21-32 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/679,335. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are oriented to an invention with the same disclosed features.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 10-12, 21-24, 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz (6,055,573) in view of Deaton (5,687,322).

Claim 1, 13, 20: Gardenswartz discloses a method for utilizing accumulated consumer sales transaction data in a system comprising a plurality of consumer sales transaction servers and a main database server, the method comprising the steps of:

retrieving the consumer sales transaction data from the plurality of consumer transaction servers;

storing the consumer sales transaction data in the main database server (Fig. 1; col 5, lines 60-65; col 5, lines 30-43; col 6, lines 1-15);

processing the consumer sales transaction data to create processed consumer sales transaction data; and

targeting the consumer with advertisements in response to the processed consumer sales transaction data (Fig. 2a; Fig. 2b; col 11, lines 43-50).

Gardenswartz further discloses an identification verification device that accesses the accumulated consumer sales transaction data based on the identification of the consumer (Fig. 5; Fig. 9); and

a video display apparatus that displays retail information in response to the identification of the consumer (col 7, lines 12-25; col 6, lines 35-40).

Art Unit: 3622

Gardenswartz further discloses online sales (col 1, lines 23-27) and tracking online sales data for consumer activity for targeted advertising purposes (col 2, lines 43-55).

Gardenswartz further discloses targeted advertising to consumers utilizing known consumer information (col 2, lines 35-43).

Gardenswartz further discloses utilizing known consumer information such as consumer mailing address information to mail information to a consumer in an offline manner via regular mail (col 19, lines 17-14).

Gardenswartz further discloses providing coupons and rewards to a consumer in an offline manner such as regular mail, at a retail store, or at a checkout counter, (col 20, lines 10-25).

The online Merriam-Webster dictionary at www.m-w.com defines 'coupon' as:

“ ...

2 : a form surrendered in order to obtain an article, service, or accommodation: as **a** : one of a series of attached tickets or certificates often to be detached and presented as needed **b** : a ticket or form authorizing purchases of rationed commodities **c** : a certificate or similar evidence of a purchase redeemable in premiums **d** : a part of a printed advertisement to be cut off to use as an order blank or inquiry form or to obtain a discount on merchandise”.

Definition 2d states how a coupon is related to an advertisement.

Additionally, Deaton further discloses utilizing consumer purchase history information to send targeted, offline advertisements or coupons to a consumer (col 7, lines 30-50; col 4, lines 3-10; col 61, lines 45-52; col 62, lines 53-56).

Art Unit: 3622

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gardenswartz can utilize online consumer activity history in any of the manners disclosed for utilizing the offline activity history information. One would have been motivated to do this in order to form a more complete picture of user activity information for targeting purposes (col 2, lines 42-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Gardenswartz's targeted offline coupon or rewards information delivered to a consumer based upon online sales information can be offline advertisements. One would have been motivated to do this in order to provide advertising in a form that is often utilized or accessed by consumers.

Claim 2: Gardenswartz and Deaton disclose the method of claim 1 wherein the step of processing includes the steps of:

standardizing the consumer sales transaction data into a predetermined format, thus generating standardized sales data; storing the standardized sales data in the main database server memory; and

accumulating the standardized sales data for each consumer such that a group of the standardized sales data relating to a specific consumer and gathered from at least one of the plurality of consumer transaction servers is assigned to that consumer in the form of a consumer data file (Fig. 2a; Fig. 2b; Fig. 1, item 8; Fig. 4a; Fig. 9; Fig 8; col 12, lines 37-48).

Claim 3: Gardenswartz and Deaton disclose the method of claim 2 and further including the step of segmenting the standardized consumer sales transaction data such that a group of

Art Unit: 3622

consumers can be defined by the group's characteristics (Fig. 4a; Fig. 9; Fig. 8; col 12, lines 37-48).

Claim 4: Gardenswartz and Deaton disclose the method of claim 2 wherein the step of standardizing includes grouping the consumer sales transaction data into a plurality of data fields that are separated by delimiters (Fig. 2a; Fig. 2b; col 8, lines 3-10).

Claim 10: Gardenswartz and Deaton disclose the method of claim 1 wherein the step of targeting includes emailing advertisements to the consumer in response to the processed sales transaction data (col 4, lines 25-45).

Claim 11: Gardenswartz and Deaton disclose the method of claim 1 wherein the step of targeting includes mailing coupons to the consumer in response to the processed sales transaction data (col 4, lines 25-45; col 14, lines 45-50; col 5, lines 54-56; col 18, lines 36-42).

Claim 12: Gardenswartz and Deaton disclose the method of claim 1 wherein the step of targeting includes telephoning the consumer in response to the processed sales transaction data (col 18, lines 36-42).

Claim 21, 22: Gardenswartz and Deaton disclose a method for utilizing accumulated consumer sales transaction data in a system comprising a plurality of consumer sales transaction servers and a main database server, the accumulated consumer sales transaction data comprising a date of purchase for retail items (col 3, line 65-col 4, line 6), the method comprising the steps of: retrieving the consumer sales transaction data from the plurality of consumer transaction servers; storing the consumer sales transaction data in the main database server (Fig. 1; col 5, lines 60-65; col 5, lines 30-43; col 6, lines 1-15);

Art Unit: 3622

processing the consumer sales transaction data to create processed consumer sales transaction data (Fig. 2a; Fig. 2b; col 11, lines 43-50).

Gardenswartz further discloses monitoring dates, periods, and purchase histories of products (col 3, line 65-col 4, line 6).

Gardenswartz does not explicitly disclose targeting the customer if a time period for the purchase of a specific item has passed.

However, Deaton discloses comparing the date of purchase of a predetermined retail item to a present date; and if the difference between the date of purchase and the present date is greater than a predetermined time period, targeting the consumer with information regarding the predetermined retail item (col 73, line 62- col 74, line 7).

Deaton further discloses that the predetermined time period is an average time required for the predetermined retail item to require replacement (col 73, line 62- col 74, line 7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Deaton's targeted advertisements based on time period passed to Gardenswartz's targeted advertisements and tracked purchased dates and item purchase history. One would have been motivated to do this in order to target users for items that are more likely of timely necessity.

Claim 23: Gardenswartz and Deaton disclose the method of claim 21. Gardenswartz further discloses that the step of processing includes the steps of: standardizing the consumer sales transaction data into a predetermined format, thus generating standardized sales data; storing the standardized sales data in the main database server memory; and

Art Unit: 3622

accumulating the standardized sales data for each consumer such that a group of the standardized sales data relating to a specific consumer and gathered from at least one of the plurality of consumer transaction servers is assigned to that consumer in the form of a consumer data file (Fig. 2a; Fig. 2b; Fig. 1, item 8; Fig. 4a; Fig. 9; Fig 8; col 12, lines 37-48).

Claim 24: Gardenswartz and Deaton disclose the method of claim 21. Gardenswartz further discloses that the step of standardizing includes grouping the consumer sales transaction data into a plurality of data fields that are separated by delimiters (Fig. 2a; Fig. 2b; col 8, lines 3-10).

Claim 29: Gardenswartz and Deaton disclose the method of claim 21. Gardenswartz further discloses that the step of targeting includes mailing discount coupons, regarding the retail item, to the consumer (col 4, lines 25-45; col 14, lines 45-50; col 5, lines 54-56; col 18, lines 36-42).

Claim 30: Gardenswartz and Deaton disclose the method of claim 21. Gardenswartz further discloses that the step of targeting includes emailing advertisements to the consumer regarding the retail item (col 4, lines 25-45).

Claim 31: Gardenswartz and Deaton disclose the method of claim 21. Gardenswartz further discloses that the step of targeting includes mailing coupons, regarding the retail item, to the consumer (col 4, lines 25-45; col 14, lines 45-50; col 5, lines 54-56; col 18, lines 36-42).

Claim 32: Gardenswartz and Deaton disclose the method of claim 21. Gardenswartz further discloses that the step of targeting includes telephoning the consumer regarding the retail item (col 18, lines 36-42).

Art Unit: 3622

5. Claims 5, 6, 25, 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz (6,055,573) in view of Deaton (5,687,322) in further view of Lech (5,258,855).

Claim 5, 6: Gardenswartz and Deaton disclose the method of claim 4, and further discloses that the data fields comprise a field for the consumer's mailing address, a field for the consumer's item of purchase, and a field for the consumer's cost of purchase, and date of purchase (Fig. 2b; col 11, lines 43-50).

Gardenswartz does not explicitly disclose a field for a consumer's age.

However, Gardenswartz discloses storing user demographic information that will assist in targeting (col 11, lines 43-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add age as user demographic information to Gardenswartz's user information. One would have been motivated to do this in order to provide further data on a user that is useful in targeting.

Gardenswartz further discloses a wide variety of tabular and database means for storing information (col 8, lines 3-10; Fig. 2a; Fig. 2b).

Gardenswartz does not explicitly disclose the utilization of a semicolon.

However, Lech discloses that the semicolon can be utilized as a data delimiter (col 11, lines 50-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the Lech's semicolon is an obvious character that Gardenswartz can utilize as a delimiter for the data. One would have been motivated to do this in order to separate data of different types.

Art Unit: 3622

Claim 25, 26: Gardenswartz and Deaton disclose the method of claim 24, and Gardenswartz further discloses that the data fields comprise a field for the consumer's mailing address, a field for the consumer's item of purchase, and a field for the consumer's cost of purchase, and date of purchase (Fig. 2b; col 11, lines 43-50).

Gardenswartz does not explicitly disclose a field for a consumer's age.

However, Gardenswartz discloses storing user demographic information that will assist in targeting (col 11, lines 43-50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add age as user demographic information to Gardenswartz's user information. One would have been motivated to do this in order to provide further data on a user that is useful in targeting.

Gardenswartz further discloses a wide variety of tabular and database means for storing information (col 8, lines 3-10; Fig. 2a; Fig. 2b).

Gardenswartz does not explicitly disclose the utilization of a semicolon.

However, Lech discloses that the semicolon can be utilized as a data delimiter (col 11, lines 50-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the Lech's semicolon is an obvious character that Gardenswartz can utilize as a delimiter for the data. One would have been motivated to do this in order to separate data of different types.

Art Unit: 3622

6. Claims 7, 8, 27, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz (6,055,573) in view of Deaton (5,687,322) in further view of Wilson (5,864,827).

Claims 7, 8: Gardenswartz and Deaton disclose the method of claim 1.

Gardenswartz further discloses the utilization of a WAN or the Internet (col 5, lines 37-42) and a network with servers and real-time communication (Fig. 1; col 6, lines 2-5).

Gardenswartz does not explicitly disclose the utilization of satellite, modem, telephone line with the Internet.

However, Wilson discloses the Internet and utilizing a telephone line, satellite, modem, dedicated line for networked communication (col 4, lines 8-19)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wilson's variety of networked communications utilizing the Internet or a WAN to Gardenswartz's networked communication utilizing the Internet or a WAN. One would have been motivated to do this in order to provide Gardenswartz with appropriate options for network communications.

Claims 27, 28: Gardenswartz and Deaton discloses the method of claim 21.

Gardenswartz further discloses the utilization of a WAN or the Internet (col 5, lines 37-42) and a network with servers and real-time communication (Fig. 1; col 6, lines 2-5).

Gardenswartz does not explicitly disclose the utilization of satellite, modem, telephone line with the Internet.

However, Wilson discloses the Internet and utilizing a telephone line, satellite, modem, dedicated line for networked communication (col 4, lines 8-19)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Wilson's variety of networked communications utilizing the Internet or a WAN to Gardenswartz's networked communication utilizing the Internet or a WAN. One would have been motivated to do this in order to provide Gardenswartz with appropriate options for network communications.

7. Claims 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz (6,055,573) in view of Deaton (5,687,322) in view of Booth (5,738,351).

Claim 9: Gardenswartz and Deaton disclose the method of claim 1. Gardenswartz further discloses targeting that includes targeted advertising that can mailed to the consumer in response to the processed sales transaction data (col 5, lines 54-56; col 18, lines 36-42).

Additionally, the online Merriam-Webster dictionary at www.m-w.com defines brochure as:

"PAMPHLET, BOOKLET; especially : one containing descriptive or advertising material".

Hence, Gardenswartz's mailed advertising material is similar to a brochure.

However, Gardenswartz does not explicitly disclose mailing targeted brochures.

However, Booth discloses targeted advertising and that targeted advertising can be in the form of targeted advertising brochures (col 1, lines 60-63).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Graham's targeted advertising brochures to Gardenswartz's mailed targeted advertising. One would have been motivated to do this in order to provide further product information that will help facilitate a user purchase.

Response to Arguments

8. Applicant's arguments with respect to claims 1-12 and 21-32 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3622

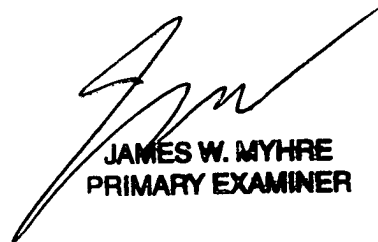
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AA

8/10/04


JAMES W. MYHRE
PRIMARY EXAMINER